

REMARKS

This Amendment After Final is prepared in response to the final Office action mailed on 26 January 2007 (Paper No. 20070116).

Status of the Claims

Claims 1 through 59 are pending in the application.

Listing of the Claims

Pursuant to 37 CFR §121(c), the claim listing, including the text of the claims, will serve to replace all prior versions of the claims, in the application.

Amendment of the Claims

No claims are amended via this Paper.

Status of Claims and Support for Claim Amendments

II-Status of Pending Claims

In paragraph 1 of the present final Office action, the Examiner required clarification of the status of the claims amended in the previous Amendment. In the Amendment filed on 21st of August 2006, claims 4 through 6 and 44 were amended. The foregoing listing of claims presents all of the pending claims pursuant to 37 CFR §121(c), bearing corrected status are attached to this Amendment After Final. Thus, claims 1 through 59 are all pending in this application.

Please note that the status indicator for the following claims have been checked, and the status indicator is correct as presented in the foregoing listing of the claims: status of claim 1 has been changed from (Amended) to (Twice Amended) - amended 2/17/00, 7/16/01; status of claim 9 has been changed from (Twice Amended) to (Amended) - amended 2/01/01.

Examiner's Response to the Applicant's Argument of 8/21/2006

In response to Applicant's arguments set forth in the Amendment filed on 21 August 2006, the Examiner states the following:

The response fails to clearly provide an explanation of the support in the disclosure of the patent for each of the changes made to the claims. In the Remarks (page 34), the applicant alleges "each of claims 1 through 8 lies in the disclosure of these claims themselves". The applicant fails to clearly identify which claims he is talking about.

The Applicant's Remarks are correct because, under Pursuant to 37 CFR §1.173(c), each of the patent claims 1 through 8 inclusive, as is explained in the following paragraphs, provides its own support for the specific amendments made to those claims in this reissue application.

No all amendments to a claim constitute "changes made to the claims"¹ under 37 CFR §1.173(c).

The attention of the Examiner is therefore also invited to consider the express language of 37 CFR §1.173(c), which reads that,

"[W]hen there is an **amendment** to the claims pursuant to paragraph (b) ..., there must also be supplied an explanation of the support in the disclosure of the patent for the **changes** made to the claims."²

Consider that 37 CFR §1.173(c) does not equate the noun *amendment* to the noun *changes*. In other words, the express language of 37 CFR §1.173(c) does not declare the noun *amendment* to be a synonym for the noun *change*. The attention of the Examiner is therefore, respectfully

¹ 37 CFR §1.173(c).

² 37 CFR §1.173(c).

invited to note that no constituent element was added to claims 1 through 8 and no constituent element was deleted from any of claims 1 through 8. Moreover, no new matter was added to any of the patent claims. Consequently, no **changes** have been made to any of claims 1 through 8. The attention of the Examiner is also invited to note that claims 1 through 8 constitute an integral part of “the disclosure of the **patent**.”³ Moreover, corrections of articles, conjugations, participles, prepositions, punctuation and tenses are corrections that are internal to the structure of the claim itself, and support for such corrections is given by the text of the claim itself.

Applicant notes that Paper No. 20070116 fails to identify any **change** to any claim for which Applicant has not supplied **an explanation** of the support in the disclosure of the **patent**.

The **explanation** of the support in the disclosure of the patent for the amendment made to the claims was given in Applicant’s Amendment of the 21st of August 2007. The claims referred to in the foregoing excerpt from Applicant’s Remarks pertain to the changes to claims 4, 5, 6 and 44 made via the Amendment of the 21st of August 2007.

In the remarks section III-B, the applicant alleges that claims 1-59 have been pending since the close of prosecution on the 9th of July 2002 and no other amendments have been made; according to the applicant, the original application is not an amendment under 37 CFR 1.121(b)(2)(C)(iii) or 1.173(c) and thus, the applicant is not required to provide an explanation of support. This is contradictory to the statements of the applicant who states that the claims are amended and it is not a proper interpretation of the rule since in a reissue application, any change to the patented claims, represents an amendment to the application and requires an explanation.

This statement is improper and legally flawed under the Code of Federal Regulations.

³ 37 CFR §1.173(c).

First, the Examiner's statement that "in a reissue application, any change to the patented claims, represents an amendment to the application and requires an explanation" has erroneously confused the requirements of 37 CFR §1.173(c); the Examiner's statement also ignores the distinctions between 37 CFR §1.121(b)(2)(C)(iii) – **Manner of making amendments in applications**, and 37 CFR §1.173(c) – **Reissue specification, drawings, and amendments**. In particular, 37 CFR §1.121(a) expressly states that "[a]mendments in applications, **other than reissue applications**" 37 CFR §1.173(c), rather than 37 CFR §1.121(b)(2)(C)(iii), regulates changes to the claims pending in a reissue application. As noted in the foregoing paragraphs, under the express language of 37 CFR §1.173(c), the noun *amendment* is not a synonym for the noun *change*.

Second, the Examiner's statement that "in a reissue application, any change to the patented claims, represents an amendment to the application and requires an explanation" is incorrect and is an ill considered paraphrase of the actual language of 37 CFR §1.173(c), which reads:

"[W]henever there is an **amendment** to the claims pursuant to paragraph (b) ..., there must also be supplied an explanation of the support in the disclosure of the patent for the **changes** made to the claims."⁴

37 CFR §1.173(c) does not purport to equate the noun *amendment* to the noun *changes*. In short, and contrary to the assertions of the Examiner, the express language of 37 CFR §1.173(c) does not declare that every *amendment* of a claim is also a *change* made to that claim. Moreover, Applicant respectfully notes that Paper No. 20070116 has not identified any *change* in any of the

⁴ 37 CFR §1.173(c).

claims. Withdrawal of this objection is therefore respectfully urged.

Third, the Examiner's statement "in a reissue application, any change to the patented claims, represents an amendment to the application and requires an explanation" has erroneously confused the text of 37 CFR §1.173(a) – **Contents of a reissue application**, with 37 CFR §1.173(b) – **Making amendments in a reissue application**, and 37 CFR §1.173(c) – **Status of claims and support for claim changes**. Neither 37 CFR §1.173(b) nor 37 CFR §1.173(c) govern the "contents of a reissue application."

Paper No. 20070116 additionally states that,

Applicant's assertion that on page 34 of the response filed 11/6/02, there is provided support for amendments to claim 1 is not persuasive and does not provide any showing of support for the amendments regarding changes of plural to singular signals, or to the addition of the language "do not" regarding the matching of code sequences.

The reason why Paper No 20070116 makes this statement is not explained in Paper No. 20070116. Claim 1 was not amended in Applicant's Amendment of the 21st of August 2007.

Paper No. 20070116 states that:

Applicant's assertion that the support for the changes to claims 4, 5, and 6 lies in the original text of patented claims 4, 5, and 6 is not persuasive since each of the patented claims simply refers to the use of a "video tape recorder . . . for reproducing a video tape".

This statement, taken from among the Examiner's comments in Paper No. 20070116 ignores the text of patent claims 4, 5 and 6, each of which when read together with patent claims 1 through 3, 7 and 8, collectively teach, *inter alia*, control of an on-screen display system able to visually

display, among other images, “error message”⁵ by the expedient of utilizing Applicant’s “on-screen display function.”⁶ An “error message” is intrinsically an “image” as stated in the amendments of claims 4, 5 and 6. In some implementations of the principles of Applicant’s inventions, a “video tape recorder . . . for reproducing a video tape” may, as is observed by the Examiner, used to store a “video signal”⁷ to produce other images including a “first video signal” and a “second video signal.”⁸ Accordingly, support for the changes to claims 4, 5, and 6 lies in the original text of patent claims, as observed by Applicant in the Amendment of the 21st of August 2006 and the Examiner’s comments in Paper No. 20070116.

Paper No. 20070116 continues by stating that,

The applicant’s assertion that the changes presented by all of the claims 9-59 lie in Figures 1, 3A and 3B in combination with Figures 1 and 4 and col. 1, lines 16-17, col. 2, lines 20-34 and col. 3, line 51 through col. 6, line 2 is not persuasive and such indication of practically the entire specification including the drawings, does not meet the requirement of providing an explanation of the support in the disclosure as required by 37 CFR 1.173. Thus, the applicant continues to fail provide explanation of support for the claim changes.

The reference to *all of the claims 9-59* in the foregoing excerpt from the Examiner’s comments on page 2 of Paper No. 20070116 is untimely because only one of the claims 9 through 59 were amended in Applicant’s Amendment of the 21st of August 2006. Moreover, this statement

⁵ Claim 7, line 20.

⁶ Claim 7, line 20.

⁷ Claim 3, line 3.

⁸ Claim 2, lines 10 and 11.

contains no relation to the amendments made in Applicant's of the 21st of August 2006, because only claims 4 and 6 were amended via that Amendment. Furthermore, in support of the amendments made via Applicant's Amendment of the 21st of August 2006, that Amendment expressly complied with 37 CFR §1.173(c) by explaining that:

“Claims 4, 5 and 6 are amended to delete ‘tape’ and thereby alter its preamble to more broadly read ‘video recorder’, and to substitute the generic phrase ‘storage medium’ for ‘tape’. Support for these changes lies in the original text of patented claims 4, 5 and 6.”

Consequently, the assertion that “the applicant continues to fail [*sic*, to] provide explanation of support for the claim changes” is unwarranted.

Paper No. 20070116 also asserts that:

For example, in claims 9 and 15, it is not seen where in the specification there is support for the language “controlling production of video images corresponding to said video components through generation of a control output for a period of time defined by a first input of lock key data followed by a secret code and a second input of said lock key data followed by said secret code.” Applicant is required to show by column and line number in the original specification where there is support for such feature.

This assertion is unfounded because no amendments of claims 9 through 15 were made in the Amendment of the 21st of August 2006. Secondly, the Examiner's assertion that “Applicant is required to show by column and line number in the original specification where there is support for such feature” is inaccurate; the original proposal for citation of column and line number was deleted from an earlier draft of the proposed amendments of 37 CFR §1.173. Currently, there is no requirement imposed under 37 CFR §1.173(c) “for citation of column and line number.”

Paper No. 20070116 further states that:

For example, in claim 20, it is not seen where in the specification there is support for a “process for operating a video system comprising making a subjective evaluation of content portrayed by a first video signal to be transmitted for reception by a video display apparatus . . . during a system power standby mode of operation selectively generating a code in dependence upon said evaluation and responding to said code by barring transmission of said first video signal to said video display apparatus.”

This statement is untimely because no amendment of claim 20 was made in Applicant's Amendment of the 21st of August 2006. The process defined by the Examiner's comment that “a ‘process for operating a video system comprising making a subjective evaluation of content portrayed by a first video signal to be transmitted for reception by a video display apparatus ... during a system power standby mode of operation selectively generating a code in dependence upon said evaluation and responding to said code by barring transmission of said first video signal to said video display apparatus’” conforms to the original process defined by claim 20 in the above-captioned application as originally filed. No amendment has been identified by Paper No. 20070116.

Paper No. 20070116 continues by asserting that,

Applicant is required to show where in the specification, by column and line number, where this process is specifically supported.

This assertion is factually inaccurate because the Examiner's assertion that “Applicant is required to show by column and line number in the original specification where there is support for such feature” is in error. The original proposal for citation of column and line number to support a

change to a pending claim of a reissue claim made via an Amendment was deleted from a very early draft of the proposed amendments of 37 CFR §1.173, in recognition of the fact support for the language of any passage of a claim is based upon the teachings of the patent, and that consequently, the patent must be considered in its entirety. Consequently, a thorough reading of 37 CFR §1.173(c) demonstrates that this section imposes no requirement “for citation of column and line number” for any purpose. It appears that the Examiner has erroneously confused the **markings** requirement imposed by 37 CFR §1.173(d)(1) and (2) and the **support for claim changes** imposed by 37 CFR §1.173(c). The **markings** requirement imposed by 37w CFR §1.173(d)(1) and (2) contemplates reference to column and line numbers. In contradistinction, the **support for claim changes** imposed by 37 CFR §1.173(c) requires not reference to column and line numbers, but “an **explanation** of the support in the disclosure of the patent for the changes made to the claims.”

Double Patenting: Rejection of Claims 1 Through 3, 8, 21 Through 24, 27, 28 and 59 Under 35 U.S.C. §101

In paragraph 9 of the final Office action (Paper No. 20070116), claims 1-3, 8, 21-24, 27, 28, and 59 are provisionally rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1-3, 8, 20-23, 26, 27, and 43 of co-pending Application Serial No. 10/337364.

In paragraph 10 of Paper No. 20070116, the Examiner responds to Applicant’s arguments set forth in Section VI-A of the previous Amendment, by writing that;

“the applicant alleges that the rejection under 35 USC 101 is moot since the claims have been correspondingly broadened. Applicant’s

arguments are not convincing and fail to provide any evidence of the differences in scope between the two applications. Applicant's assertion that a Terminal Disclaimer will be filed at the completion of the review of the instant application is not persuasive since a rejection under 35 USC §101 for claiming the same invention cannot be overcome by a Terminal Disclaimer. If applicant maintains the argument regarding differences in scope he is required to specifically point to the claim language providing such distinctions between the two applications."

- A. Claims 1 through 3, 7 through 19, 21 through 43 and 59 are provisionally rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1 through 3 and 7 through 43 of co-pending application Serial No. 10/337,364.**

In view of Applicant's foregoing amendments of claims 1 through 3, 7 through 19, 21 through 43 and 59 to correspondingly broaden the scope of coverage provided by these claims, this rejection is moot. Nothing in either Paper No. 20060207 nor Paper No. 20070116 addresses these distinctions, and the record is devoid of any demonstration by the Examining staff that these claims in fact claim the "same invention." Moreover, nothing in 35 U.S.C. §101 denies an Applicant to have more than one patent covering different aspects, features, implementations or embodiments based upon the same specification. Where, as here, the divisional application is filed pursuant to 35 U.S.C. §121 due to a requirement for restriction imposed by the Examiner, even where that restriction is subsequently withdrawn, the parent application may not be cited against the divisional application. Withdrawal of this rejection is therefore respectfully urged.

Rejection of Claims 4-7, 9-19, 25, 26 and 35-43 Under Non-Statutory Obviousness-Type Double Patenting

In paragraph 12 of Paper No. 20070116, claims 4-7, 9-19, 25, 26, and 35-43 are

provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4-6 of copending Application No. 10/337,364.

The Examiner states that;

“Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 4-6 of the instant application is generic to claims 4-6 of the co-pending application and fully encompasses the scope of the co-pending claims and therefore anticipates the copending claims.”

The Examiner further states that;

“The claims are not distinct from claims 9-19, 24, 25, 34-42 of the copending application since the step of ‘selectively input from a keyboard or a remote control receiver’ is obvious in light of ‘selectively input by a user of the video system’ since the input by a keyboard necessitates the input of a user and there is no patentable distinction between ‘a microprocessor based controller’ and ‘a microcomputer’.”

The Examiner contends that Applicant has not provided any recitation of the distinction between the sets of claims in the present application and the co-pending application, Application Serial No. 10/337,364.

B. Claims 4-6 are provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 4 through 6 of co-pending Application No. 10/337,364.

The Examiner contends that “[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because one of ordinary skill in the art would find it obvious/know that a video cassette tape is a video storage medium and that a video tape recorder

is a video recorder.”

Upon completion of review of this re-issue application with Applicant’s co-pending Serial No. 10/337.364, a terminal disclaimer and, if indicated, a Supplemental Reissue Declaration from the Assignee, will be filed. In the interim, the Examiner is requested to suspend these formalities.

VII. Rejection Of Claims 44-58 Under First Paragraph Of 37 C.F.R. §112 – Enablement

In paragraph 22 of Paper No. 41, claims 44 through 58 are rejected under the *first* paragraph of 35 U.S.C. §112 as allegedly “failing to comply with the enablement requirement.”

In support of this rejection, the Examiner argued that

“[t]he claim(s) contain subject matter which was not described in the specification is such a way as to enable one skilled in the art ... to mark and/or use the invention.”⁹

This rejection and the conclusion given by the Examining staff in support of this rejection, are unsupported by evidence in the record.

In support of this rejection the Examining staff wrote that,

“claims 44, 48, 55 and 56 set forth a process wherein a first lock key data signal is received and a second lock data key signal is received after the first lock key data signal, such receiving times being separated by an interval”

It is unclear here whether the Examining staff is referring to the sequential input of lock key data signals illustrated by Figure 3A or to the successive input of lock key data signals illustrated by Figure 3B. In either event, this process is found in the progression of process steps 11 through

⁹ Paper No. 41, page 10.

17 illustrated by Figure 1. Applicant notes however, that “receiving times being separated by an interval” is not language found in claims 44, 48, 55 or 56. Clarification in subsequent Office correspondence is respectfully requested. In view of the clear demonstration of enablement in the originally filed application of the inventions actual defined by claims 44, 48, 55 and 56, this rejection is unfounded; its withdrawal and allowance of claims 44 through 58 is respectfully requested.

Claim 47

In paragraph 17 of Paper No. 20070116, the Examiner states that the rejection is not overcome as Applicant has failed to show where a teaching is provided in the original specification for comparing an entered secret code to a stored code and subsequently locking audio while releasing muting of the video. The Examiner’s attention is respectfully invited to Figure 2, to note Applicants enabling teaching of operationally distinct Video Mute Circuit 107 and to Audio Mute Circuit 108, and to Applicant’s teaching of different control leads 9, 10 applied by MICOM 100 to separately control the base electrodes respectively, of Video Mute Circuit 107 and to Audio Mute Circuit 108. This is a full and complete written description teaching one of ordinary skill in the art how to make and to use Applicant’s invention, as defined by Claim 47. Accordingly, withdrawal of this rejection is respectfully urged.

VIII. Rejection Of Claims 44-58 Under First Paragraph Of 37 C.F.R. §112 – Written Description

In paragraph 23 of Paper No. 41, claims 44 through 55 are further rejected under the *first*

paragraph of 35 U.S.C. §112 as allegedly containing subject matter which was not described in the specification. In support of this rejection, the Examiner asserted that:

“[t]he claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art ... that the inventor(s) at the time the application was filed, had possession of the claimed invention. Claims 44, 48, 55 and 56 are insufficiently disclosed in the specification as originally filed.”¹⁰

This rationale is inadequate to support a rejection under the written description requirement of the first paragraph of 35 U.S.C. §112. Applicant therefore respectfully traverses this rejection, and requests its withdrawal.

First, the reasoning given by the Examiner in support of this rejection is rather convoluted, and appears to turn upon the language of claim 5, but the interpretation of that language cited by the Examiner is a paraphrase of claim 5, and that paraphrase is incomplete. Moreover, that paraphrase is not language which appears in claim 5. As demonstrated below, the use of a garbled version of a claim by the Examining staff is improper, and is inadequate to support a rejection under the written description requirement of the first paragraph of 35 U.S.C. §112.

Second, it is highly unorthodox to apply the language of claim 5 to support a rejection of claims 44, 48, 55 and 56 under the written description requirement of the first paragraph of 35 U.S.C. §112. Each claim necessarily differs.

Third, the Examining staff asserts that,

[c]laim 5 ... added a limitation of generating first and second

¹⁰ Paper No. 41, page 10.

control outputs for a period of time defined by ... [but] the specification does not provide an enabling disclosure for such limitation particularly in light of the fact that in each instance of receiving a lock key data signal, video is reproduced or received and displayed”¹¹

This rationale of the Examining staff is factually incorrect; not only has this issued already been addressed by the Board of Patent Appeals and Interferences, but neither claim 44, 48, 55 nor 56 use language such as “generating first and second control outputs for a period of time” or “in each instance of receiving a lock key data signal, video is reproduced or received and displayed.” Accordingly, there is no basis for maintaining this rejection. It withdrawal is respectfully requested.

Fourth, the Examining staff writes that,

“there is no support in the specification as originally filed for determining a match of first and second lock key data signals”

Perhaps the Examining staff should consider Applicant’s Figure 1, steps 15 or 16, among other teachings of Applicant’s original specification. In view of this, there is no basis for maintaining this rejection. It withdrawal is respectfully requested.

IX. Rejection Of Claims 44-58 Under Second Paragraph Of 37 C.F.R. §112

In paragraph 24 of Paper No. 41, claims 44 through 58 are also rejected under the *second* paragraph of 35 U.S.C. §112 as being allegedly indefinite. Applicant addresses each instance of indefiniteness alleged in the following paragraphs.

¹¹ Paper No. 41, page 10.

Claim 44

Paper No. 41 states that,

“The language ‘locking said video signal and preventing application of said video signal to enable said mixing in dependence upon said determination’ is indefinite and fails to clearly and distinctly set forth the invention. What is the difference between ‘locking said video signal’ and ‘preventing application of said video signal’? The language ‘preventing application of said video signal to enable said mixing’ is contradictory since ‘preventing application of said video’ and the ‘enabl(ing) said mixing’ appear contradictory.”¹²

It is unclear why the Examiner has divided the ultimate paragraph into two clauses, and has not read the ultimate paragraph of claim 44 as it is written, in a single clause; when read in its entirety, claim 44 is accurate and definite. The Examiner has however, dissected the ultimate paragraphs of claim 44 and then questioned,

“[w]hat is the difference between *locking said video signal* and *preventing application of said video signal to enable said mixing*?”¹³

As written, claim 44 defines a process comprised of, among other features,

“mixing said video signal and said first character signal; ... mixing said video signal and said second character signal ...[and] locking said video signal and preventing application of said video signal to enable said mixing”

The short answer to the Examiner’s question is that *locking said video signal* is one part of one possible implementation of Applicant’s process and *preventing application of said video signal to enable said mixing* is another part. A more complete answer dwells upon the fact that a

¹² Paper No. 41, pages 11 and 12.

¹³ Paper No. 41, pages 11 and 12.

“mixer” is not a node; timing is everything in video signal processing because the basic property of a mixer ‘is that its output is not directly proportional to its input, but to the product of its inputs; when signals of different frequencies are applied to such a device, the output contains not only the original frequencies but also frequencies equal to the sum and difference of the original frequencies.”¹⁴ In a general definition, a “mixer” is a circuit “in which two or more signals are **combined**.”¹⁵ In video circuits, a “video mixer” is a circuit that “allows video images to be combined and creates sophisticated translations between scenes.”¹⁶ With most signals applied to a mixer, the phases and the synchronization of the signals applied to the mixer are important. With a video mixer, in the NTSC system used in the United States and in Japan, there are thirty frames per second, and thus sixty fields per second, while in extended definition (EDTV) and in high definition (HDTV) there are several hundred lines per frame. The time base of the video signal determines when each line, each field, and each frame begins. A clear, steady picture, devoid of jumpy images, flagging or waving verticals, requires an accurate, unchanging time base because if the lines start early or late, the visual video image will shift or waver in various ways; the wiggles in the video image are time-based errors. Two distinct video signals obtained from different sources are unlikely to be synchronized. When combining two or more video signals for example, one signal can not start at line 55 while the second signal subsequently begins at line

¹⁴ Bartleby.com, *The Columbia Encyclopedia*, 6th Edition, 2001-05.

¹⁵ Bartleby.com, *The Columbia Encyclopedia*, 6th Edition, 2001-05.

¹⁶ focusinfo.com, *Mixing Video Sources: Digital Video – Focus Enhancements*, 4 October 2005.

1; the image will be unviewable. Moreover, with HDTV, absent precise synchronization, and with pixel addressed flat screen displays such as thin-film-transistor (TFT) or plasma display screens, because the video signals are binary (*i.e.*, in the vernacular, “digital”) signals, the visual display driven by the combined video signals will be illegible. A mixer assures time-base corrections and frame synchronization, typically with sufficient memory to store part of the video pictures. One technique of mixing uses the vertical and horizontal synchronization signals derived from one video signal to control the combination of two signals, such as a video signal and an on-screen character generator. Devices such as that disclosed by Rew ‘085 however, deliberately avoid combining video signals, and have no need of a mixer because they experience no problems of time-base correction or of line or frame synchronization.

Although the rationale given in Paper No. 41 for this rejection is unclear, Applicant has amended claim 44 to change the paragraph “locking said video signal and preventing application of said video signal to enable said mixing in dependence upon said determination” so as to read --locking said video signal by preventing application of said video signal to enable said mixing in dependence upon said determination – in view of the question raised by the Examining staff.

Claim 47

Paper No. 41 asserts that claim in 47,

“the language ‘locking said audio signal and releasing said muted video signal in dependence upon’ the determination of whether a second lock key data signal is identical to a first lock day data signal is not clear since it is not understood why the audio would be

locked and the video would be unlocked”.¹⁷

It is unclear whether the Examiner has considered that as disclosed in Figure 2 of Applicant’s original specification, Applicant’s invention may be practiced with separate audio processing circuit stage 104 and video processor circuit stage 103; or that these stages 103, 104 may, in one implementation of Applicant’s invention, practiced with different video mute circuit unit 107 and audio mute circuit unit 108; or that a video mute control signal is applied via lead 9 and an audio mute control signal may be applied via a different lead 10. A question of indefiniteness may not be predicated upon an artificial dissection of the language of the claim, because the claim must be read in its entirety. Clarification is subsequent Office correspondence is respectfully requested in order that Applicant will be able to fairly respond. Absent clarification, it is sufficient to note that audio processing circuit stage 104 and video processor circuit stage 103, or video mute circuit unit 107 and audio mute circuit unit 108, or a video mute control signal applied via lead 9 and an audio mute control signal applied via a different lead 10 need not be simultaneously in identical states; consequently, there is no indefiniteness present in claim 47, and there is no basis for maintaining this rejection.

Claims 50-52 And 58

Paper No. 41 stated that,

“the determination of whether the second lock key data is identical to a reference and the subsequent changing of the locking/unlocking state in dependence thereon is not clear since the ‘reference’ is

¹⁷ Paper No. 41, page 11 and 12.

undefined and not specified in the specification”.¹⁸

It is unclear whether the Examiner is arguing for a proposition that the express language of each claim be found *verbatim* in the specification. Not only is there is no support for this proposition in either the statute or the Code of Federal Regulations, but the second paragraph of 35 U.S.C. §112 does not require that each and every claim contain only those nouns found in the specification.

Although this rejection is couched in terms of claims 44 through 58 “being indefinite” and as “failing to particularly point out and distinctly claiming the subject matter which applicant regards as *the* invention,”¹⁹ the rationale given by Paper No. 41 is not written in these terms, but is rather written in terms questioning the breath and scope and of claims 44 through 58. The term “reference” is self-defining, and is used in parallel with “ the second lock key data” and “identical”; the relationship between “the second lock key data” and “reference” is well defined, precise and inescapable in its meaning and clarity in this passage; any additional verbiage in this claim directed to the “reference” would concomitantly limit the scope of coverage provided by claims 50 through 52 and 58 .

Moreover, in presenting this argument in support of an indefiniteness of claims 50 through 52 and 58 the Examiner is arguing that the scope of Applicant’s claims must each conform completely and exactly to the embodiments disclosed in the specification, without regard to the fact that under the statute, the specification and claims serve distinctly diverse offices. Under the

¹⁸ Paper No. 41, page 12.

¹⁹ Second paragraph of 35 U.S.C. §112.

second paragraph of 35 U.S.C. §112, no restriction is placed upon the scope of the Applicant's claims; the sole restriction placed upon the claims is that the claims particularly point out and distinctly claim:

“the subject matter which *the applicant* regards as his invention”.²⁰

It appears that this rejection is premised upon the Examiner's belief that the language of each claim must be identical to the other claims, that no generic term be used to describe a species detailed in the specification, and that each passage of a claim have antecedent basis in the language of the specification; this is not U.S. practice and Paper No. 41 cites no authority for this proposition.²¹

In summary, these rejections of claim 44 through 58 under the second paragraph of 35 U.S.C. §112 raise no question about whether the Applicant here has particularly pointed out and distinctly claimed the subject matter which the Applicant regards as his invention; whether each claim is written to use only nouns printed in some part of the specification is immaterial to questions under the second paragraph of 35 U.S.C. §112. Once the specification satisfies the criteria of the first paragraph of §112, the breath of the claims is left under 35 U.S.C. §102 and §103, to the state of the art as that art existed at the time of Applicant's invention. Here however, Paper No. 41 has questioned the definiteness of claims 44 through 58 on grounds that the

²⁰ Second paragraph of 35 U.S.C. §112.

²¹ The Examiner's attention is invited to note that under the second paragraph of 35 U.S.C. §112, Congress has bestowed upon solely *the applicant*, and not upon the Commissioner or upon the Examiner, the prerogative of determining the “the subject matter *which he regards* as his invention.”

language of these claims is not identical to the specification and that the language of claims 44 through 58 differs from the language of the other pending claims; this observation does not however, raise a question of whether claims 44 through 58 are “claims particularly pointing out and distinctly claiming the subject matter which *the applicant* regards as his invention”.²² Consequently, there is no basis in the record for continuing this rejection. Its withdrawal is respectfully requested.

Rejection of Claims 20, 44, 45, 47-51 and 54-58 Under 35 U.S.C. §251

In paragraph 29 of Paper No. 20070116, claims 20, 44, 45, 47-51 and 54-58 are rejected under 35 U.S.C. §251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

The Examiner cited the following: *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984).

In support of the rejection, the Examiner has previously asserted that;

“A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. §251, and the broader scope of claim subject

²² Second paragraph of 35 U.S.C. §112.

matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.”

Reissue Applications

- G. **Claim 20 is rejected under 35 U.S.C. §251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.**

Without giving consideration to the extensive explanation given in Applicant’s response to Paper No. 20060207, the Examiner summarily refers to the rejection to the previous Office Action, paragraphs 42-51, where the Examiner contends that:

Claim 20 is a process claim and therefore must relate in scope only to like method/process claims of the patent, which claims are claims 1, 7 and 8 of the patent. Claims 7 and 8 of the patent are directed to methods for locking/unlocking a display screen or VTR, while patent claim 1 is directed to a method of operating a video system.

The first step requires the examiner to review the claim for the presence of broadening, as compared with the scope of the claims of the patent to be reissued. A reissue claim is broadened where some limitation of the patent claims is no longer required in the reissue claim. That is, a claim of a reissue application enlarges the scope of the claims of the patent if it broader in at least one respect, even though it may be narrower in other respect. In the instant case, claim 20 is broadened since at least one limitation, such as **displaying a lock function setting state . . . and sequentially storing and displaying a secret code of a user**, is no longer required.

The second step requires the examiner to determine whether the broadening aspects of the claim relate to subject matter that applicant previously surrendered during the prosecution of the original application. There are two sub-steps involved with this step. Thus, it must first be determined whether there was any surrender of subject matter in the prosecution of the original patent. The reliance by applicant on a claim limitation to define the original

patent claims over the prior art can be made by way of presentation of new/amended claims or an argument/statement by the applicant that a limitation defines over the art. The following arguments by the applicant were presented in the prosecution history to overcome a rejection over the prior art.

The parent application, 07/398,927, set forth a single claim drawn to a locking method for a system with OSD. In response to an Office Action rejecting claim 1 over prior art, the applicant responded with arguments “in contradistinction, applicant’s process includes steps such as (a) **displaying a lock function setting state and sequentially storing and displaying a secret code of a user**”, (b) **comparing the secret code with a stored code and displaying an error message**, and (c) **initializing the stored code with the secret code displayed**. (See Response filed 5/24/90, page 4). A continuing application 07/681,843, with additional method claim 2 having limitations substantially similar to those of claim 1 as well as apparatus claims 3-4 were added. In filing the preliminary amendment, the applicant again repeated the arguments set forth above with respect to the prior art (See Response filed 9/21/90). In applicant’s response filed 2/3/92, the applicant argues the claims over the prior art since the prior art fails to teach or suggest **checking for an input from a lock key during a power stand-by state and remaining in the power standby state until such time as an Input from the lock key is detected** (mail date of response 1/27/92, page 9). In the same response, the applicant argues for distinction over the prior art since the prior art fails to teach or suggest **checking to determine If the system is in a lock mode and storing an input secret code as a lock code and muting the video and audio, if the system is not already set in the lock mode** (mail date of response 1/27/92, page 10). In a response filed 8/29/92, the applicant again argued that the prior art failed to teach or suggest **checking for an input from a lock key during a power stand-by state and remain in the power standby state until such time as an Input from the lock key is detected** (page 6). In the same response, the applicant again argues for distinction over the prior art since the prior art fails to teach or suggest **checking to determine if the system is in a lock mode and storing an input secret code as a lock code and muting the video and audio, if the system is not already set in the lock mode** (page 7). The

applicant further indicates that the prior art does not disclose **the sequential displaying and storing of the characters of the input secret code** (page 7). The Board of Appeals made a ruling that claim 8 of the application 08/024,495 (which became claim 7 of the patent) distinguished over the prior art combination since it failed to disclose (1) “checking for a key data signal input from said keyboard or remote control during a system power standby mode of operation”, (2) “displaying prompts . . . storing and displaying, on said screen, a secret code input by a user in response to said prompts”, and (3) storing the secret code as a lock code, clearing said screen of said prompts . . . and locking the on-screen display when the determining step determines that the on-screen display system is not in said locked state.” Thus, the prosecution history shows that the applicant relied on specific, stated and argued claim limitations to define over the prior art; thus, it is deemed that there was a surrender of subject matter.

The second substep determines whether any of the broadening of the reissue claims is in the area of the surrendered subject matter. In claim 20, the applicant has omitted in their entirety all of the limitations, set forth above in paragraph #49, that the applicant relied upon to define patentability in the prosecution history. Thus, it is determined that claim 20 is broadened in the area of surrendered subject matter.

The third step requires the analysis of the broadening and narrowing effected via the reissue claims and of the significance of the claim limitations added and deleted to determine whether the reissue claims should be barred as recapture. In claim 20, there is no narrowing of scope in any manner. The limitations presented, argued, or stated to make the claims patentable over the prior art generates the surrender of claimed subject matter and is therefore referred to as the surrender-generating limitation. If a claim is presented in a reissue application that omits in its entirety, the surrender-generating limitation, that claim impermissibly recaptures what was previously surrendered, and that claim is barred under 35 USC 251.

The fallacy in the Examiner’s logic resides in the Examiner’s failure to consider that under the

doctrine of claim differentiation, patent claims 1, 7 and 8 necessarily differ in scope. Those differences have not been identified in the Examiner's logic. Moreover, the Examiner has neglected to identify any "surrender-generating limitation."

Applicant raised three (3) issues under the first question, of whether Claim 20 was improperly rejected under 35 U.S.C. §251, and seven (7) separate issue under the second question, of whether there is evidence in the instant record that fairly justifies a rejection of claim 20 under the doctrine of reissue recapture. The Examiner has only superficially addressed the three issues raised by the first question (*i.e.*, issues I.A, I.B and I.C), and has only made a cursory, albeit incomplete presentation of *Pannu v. Storz Instruments*, 59 USPQ2d, 1600 (Fed. Cir. 2001) and *Hester Industries, Inc. v. Stein, Inc.*, 46 USPQ2d 1641 (Fed. Cir. 1998) to address the three of the first four (*i.e.*, issues II.D, II.F and II.G) of the seven issues raised by Applicant's second question; the Examiner has not addressed the facts presented in Applicant's argument and has implicitly conceded the third of the seven issued raised by Applicant's second question (issue II.E). In addressing the fifth issue raised by Applicant's second question, the Examiner seems to assert that 22nd of July 1997 Opinion of the Board in Applicant's patent, created "lesser limitations", even though the single patent claim 7 then before the Board was subsequently issued without amendment. The Examiner appears to properly concede the correctness of Applicant's presentation on the last two issues raised by Applicant's second question (*i.e.*, issues II.J and II.K), and has not made any argument traversing Applicant's issues II.J and II. K.

I. Claim 20 Was Improperly Rejected Under 35 U.S.C. §251.

Independent claim 20 stands finally rejected under 35 U.S.C. §251 as being drawn to recaptured subject matter. This rejection is improper for the following reasons.

D. 35 U.S.C. §251 Neither Invokes An Impermissible “Point-Of-Novelty” Test Of Patentability Nor Limits The Scope of Coverage Attainable With A Reissue Claim By Mandating That Each Reissue Claim Have As Included Limitations One Or More Of The Reasons Articulated By The Board Of Patent Appeals And Interferences For Refusing To Sustain A Final Anticipation Rejection Of A Patent Claim.

In support of this rejection, the Examiner now asserts that:

“[t]he arguments and limitations presented then must at least now be relied upon to define why the present claim 20 of related scope should be considered allowable over the same.” Examiner’s Answer, page 4.

The Examiner’s reliance upon the reasoning given by the Board of Patent Appeals & Interferences in refusing to sustain the anticipation rejections of patent claim 8, were previously addressed by Applicant in the remarks of Applicant’s amendment filed on the 21st of November 2001; the Examiner has now withdrawn the anticipation rejection of claim 20, but has raised the same issue under the guise of reissue recapture to support a rejection under 35 U.S.C. §251.

First, the Examiner’s reliance is misplaced and confuses the issue of reissue recapture, because the Examiner has, among other reasons, ignored both the express holdings and the rationale given by the Board for those holdings in the following numbered paragraphs:

- “19. After considering the contested limitations, we do not find a preponderance of evidence supporting a finding of anticipation under 35 U.S.C. §102(b) in view of Bonneau.”
- “27. In light of the above findings, the preponderance of evidence does not support a finding of anticipation under 35 U.S.C. §102(b) in view of Amano.”

- “13. Thus, we construe ‘checking ... during a system power standby mode close inside’ (claim 8) to mean running the key-checking function while the main system power is off. Bonneau discloses no equivalent requirement for starting the locking process from a system-power-off state. Thus, Bonneau does not anticipate the claimed invention.”
- “14. Bonneau displays two kinds of prompts for entry of a security code: a blank screen (8:22-24) and a blinking screen (7:50-53). Bonneau displays the blank screen during security-code entry so the code cannot be observed. Applicant, however, discloses acts of prompting for each digit of the code independently and of displaying each digit as it is entered. (Paper 1 at 8-11; Fig. 4.) Thus, Bonneau’s U.S. display step is not equivalent to the claimed display step.”
- “16. Bonneau does not, however, have a step equivalent to Applicant’s process of clearing the existing code or setting a new code each time. (Paper 1 at 12-13.) Moreover, since Bonneau does not display the code, it cannot clear the code from the display.”
- “22. Amano has nothing equivalent to Applicant’s claim limitation that the system power be off during the checking step. The system power is on during Amano’s code entry steps. (5:36-45; Fig. 3.)”
- “24. Amano is silent about whether the entered lock code is stored. Nothing in Amano suggests a step equivalent to Applicant’s step of storing a new code if the system is not locked.”

In short, the Board did not engage in an impermissible *point-of-novelty* determination of patentability; the Board considered patent claim 7 in its entirety. Consequently, the Examiner’s resurrection of this issue under a guise of recapture rejection under 35 U.S.C. §251, as opposed to the anticipation rejection to which Applicant’s amendment of the 21st of November 2001 was formally addressed, is misplaced.

As was earlier explained, the seminal judicial decision of *Pannu v. Storz Instrument, Inc.*, Fed. Cir. 00-1482, 7/25/2001 (decision) refers to U.S. Patent No. 4,436,855 (the Examiner’s attention is drawn to the fact that the decision of the Court is incorrect, and that the Pannu ’855

is actually U.S. Patent No. 4,435,855) and Re32,525. All claims in the '855 patent defined the haptics as having “a continuous, substantially circular arc having a diameter greater than the diameter of the lens body,” while reissue claims 1 through 10 in the '525 reissue patent deleted this limitation. There were no other independent claims in the '855 Pannu patent; consequently, *all* claims contained the same limitation. In view of the amendments of all claims to add the “two flexible and supporting elements” *and* the accompanying arguments presented by Pannu during prosecution of the '855 patent, the Court properly held that an attempt to obtain a broader definition of the haptics constituted a recapture of subject matter surrendered during the prosecution of the '855 patent.

A similar result may be found in *Hester Industries Inc. v. Stern Inc.*, 64 USPQ2d 1641 (Fed. Cir. 1998) where all of the original claims defined cooking “solely with steam” supplied by “two sources of steam”, which limitations were deleted from the reissue patent. There, the Court properly held that the reissue patent was invalid.

In the instant application however, the Examiner has focused upon Applicant's “system power stand-by state” as defined by issued independent method claims 7 and 8, and has asserted that the absence of this limitation from the rejected claims constitutes impermissible recapture. The Examiner has ignored however, the fact that independent method claim 1 defines not the “system power stand-by state” of patent claim 7, but instead defines simply a “stand-by mode of operation” while independent patent apparatus claim 2 defines a “stand-by mode of operation.”

The rejected claim 20 also defines a “stand-by mode of operation” as opposed to the

“system power stand-by state” of patent claim 7 argued by the Examiner. In view of the fact that patent claims 1 through 6 and 8 were not addressed by the Board of Patent Appeals and Interferences and were not the subject matter of the arguments presented by Applicant for patentability of patent claim 7, there is no basis for arguing recapture. Neither *Pannu* nor *Hester Industries* dictates a recapture rejection of Applicant’s claim 20 because Applicant’s rejected claim 20 is directed to different subject matter than Applicant’s patent claim 7, while the *Pannu* and *Hester Industries* applicants presented as reissue claims, the patent claims amended to delete the very limitations presented during prosecution to overcome the prior art. In essence, both the *Pannu* and *Hester Industries* reissue applicants presented reissue claims that were directed to the same subject matter as their patent claims, with the reissue claims differing from the patent claims principally by the omission of specific limitations that had served to distinguish their patent claims from the prior art. Neither the *Pannu* nor *Hester Industries* panels of the United States Court of Appeals for the Federal Circuit either held, nor even addressed the issue of whether those reissue applicants were entitled to present reissue claims directed to inventions that were substantively, structurally or operationally different from the inventions defined by their patent claims.

Second, the decision of the Board was limited to patent claim 7; rejected claim 20 differs substantially in content, subject matter and definition of Applicant’s inventions. As explained in Applicant’s remarks filed on the 21st of November 2001, the rationale given by the Board for its several holdings in its decision of the 22nd of July 1997, does not create some sort of estoppel that forbids Applicant from further presenting any claim that does not contain a verbatim recitation

of all of the limitations of patent claim 8. Evidence of this may be gleaned from the fact that issued patent claims 1-7 were not before the Board, but were in fact allowed by the Examiner prior to the decision of the Board, even though these claims had earlier been rejected as rendered obvious by the same Amano and Bonneau references. Patent claims 1 through 6 and 8 differ in their coverage of different implementations and embodiments of Applicant's invention, differ in the language to define the structural, features and process steps of those inventions, and differ in their definitions of the circuits, or process steps, required to practice the corresponding invention. Claim 20 similarly differs from patent claim 8. The fact that the Board, in its thoroughness while reviewing the final rejection of patent claim 8 gave several reasons for refusing to sustain the final rejection, does not now mandate that reissue process claim 20 recite the same patentably distinguishing features of patent claim 8. It is respectfully suggested therefore, that claim 20 is not similar to process patent claim 8, and that the Board did not have the opportunity when considering patent claim 8 of also considering reissue claim 20.

Moreover, it is the decision of the Board, rather than the reasoning given by the Board in support of its decision, that constitutes the jural fact. Often, the reasoning is simply *obiter dictum*, which itself does not carry legal effect. The Examiner's reliance upon the reasoning given by the Board for its decision is consequently misplaced, and should be withdrawn.

E. 35 U.S.C. §251 Does Not Require A Reissue Applicant "To Only Correct Errors In The Parent Patent Method Claims."

The Examiner has newly asserted that "any method claim is required in reissue

proceedings under 35 U.S.C. §251 to only correct errors in the parent patent method claims.” Examiner’s Answer, page 4. The Examiner cites *Pannu v. Storz Instruments, Inc.*, 59 USPQ2d at (1600 Fed. Cir. 201) as supporting a reissue Applicant’s presentation of method claims.

Third, The Examiner’s *idee fixe* that the feature of “checking for a key-data input signal from said keyboard or remote control during a system power standby mode” (Examiner’s Answer, page 4) referred to by the Board in paragraph 13 of its 1997 Decision and found in patent claim 7, ignores Applicant’s patent claim 1’s definition of “when ... is in said standby mode of operation, receiving a lock function code” Even assuming *arguendo* that the reasoning given by the Board in its 1997 Decision creates a reissue estoppel, reissue claim 20 is, in the particular clause of the Examiner’s *idee fixe*, more comparable to patent claim 1 than to patent claim 7. There is a telling incongruity in the Examiner’s insistence that reissue claim 20 must include patent claim 7’s step of “**checking** ... during a system power standby mode”, while not insisting that reissue claim 20 also include patent claim 1’s step of “**receiving**” during a “standby mode of operation.” The incongruity is easily explained by reading patent claims 1 and 7 and reissue claim 20; this incongruity occurs because patent claims 1 and 7 and reissue claim 20 are each directed to different subject matter. Unlike *Pannu* and *Hester Industries*, where the patent and reissue claims differed only in scope, here Applicant’s reissue claim 20 differ in substantive content, structural aspects and the inter-cooperation between their structural aspects. There is no basis to sustain this rejection provided by the Examiner’s attempt to assert a reissue claim 20 do during their respective standby modes of operation.

Moreover, and most significantly, and unlike the Applicant in *Pannu* and *Hester Industries*,

Applicant here never argued non-obviousness before the Board of Appeals in the parent application. *See*, for paragraph 8 of the Board's findings, where the Board wrote "Curiously, Applicant does not challenge the examiner's rejection for obviousness in his brief." The Board continued however, by finding that the Examiner simply had not met "the burden of establishing unpatentability by a preponderance of the evidence." Absent challenge by Applicant then, there is no basis for the Examiner to now assert recapture. The rejections for recapture are unfounded on the record, and should not be sustained.

Procedure for Determination of Recapture

The Examiner's attention is invited to the reasoning of the Court in the *Pannu* decision, where the Court explains that the application "of the recapture rule is a three step process. The first step is to determine whether and in what aspect the reissue claims are broader than the patent claims. The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. Finally, the Court must determine whether the reissue claims were materially narrowed in other aspects to avoid the recapture rule. These three steps are set forth in the *Manual of Patent Examining Procedure*, §1412.02 (8th ed.).

As explained in the *Manual*,

"If the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable *over a rejection or objection* made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists." §1412.02

The Examiner has confused the arguments presented on behalf of patentability of what is now

claim 8, with prosecution of what are now claims 1 through 7. Independent method claims 2 and 9 were presented in Applicant's Preliminary Amendment filed on 1 March 1993, together with independent apparatus claims 3 and 5 (now claims 2 and 4). The issues raised by the Examiner about *standby state* were raised by Applicant in an unanswered Petition under 37 C.F.R. §1.181 filed on 12 January 1994 and an unanswered renewed Petition under 37 C.F.R. §1.181 filed on 17 February 1994. It is disingenuous for the Examiner to now raise these issues, when the original Petitions remain unanswered by the Director.

Moreover, independent method claims 2 and 9, which are now patented method claims 1 and 8, were never amended and were never argued as being distinguishable over the art due to the presence of “during said power standby mode”. Similarly, independent apparatus claims 3 and 5 (now patented claims 2 and 4) were neither amended nor argued to either include or as distinguished over the art due to the presence of the limitation “during a system power standby state.” This limitation was present in originally drafted claim 8 filed on 10 May 1993, and was neither amended to avoid art or to otherwise obtain allowance of claim 8, simply because this limitation was never amended and it was the Board, rather than the Examiner, who allowed claim 8. Consequently, the first step applied in recapture rule, that is, identifying a limitation that “was originally presented/argued/stated in the original application to make the claims allowable over a rejection made in the original application”, is wholly absent here. MPEP §1412.02.

Arguments Made During Prosecution

Furthermore, Applicant has surrendered nothing during the prosecution of the parent application. As explained in §1412.02,

“argument (without amendment to the claims) in the original application
may be sufficient to establish recapture.”

Here, Applicant never argued the phrase “during the system power standby state” in conjunction with the allowance of independent apparatus claims 3 and 5 (now claims 2 and 4) simply because that limitation is not present in these apparatus claims. Moreover, Applicant never argued this limitation in conjunction with the allowance of independent method claims 2 and 9 (now claims 1 and 8), as is evident in the Remarks of Applicant's Amendment filed on 30 June 1994. It was the subsequent Office action, and the Advisory Action dated 8 July 1994 that allowed claims 2 through 7 and 9. With exception of one issue under the second paragraph of §112 pertain to claim 3, the Remarks in that Amendment were directed to patentability of claim 8, which was subsequently allowed by the Board. Applicant's unanswered Petitions of the 12 January 1994 and 17 February 1994 dealt with the procedure followed by the Examiner, and presented neither arguments nor amendments of subsequently allowed claims 2 through 7 and 9. The Examiner's attention is directed to pages 9-11 of Applicant's long unanswered Petition of 17 February 1994, where claims 2 through 7 and 9 were discussed. The word “standby” does not appear anywhere in these discussions. No amendments of these claims were made to add any limitation of “standby”. Similar arguments are set forth in pages 8-10 of Applicant's earlier filed, but also long unanswered Petition dated 12 January 1994. In view of the failure and refusal of the Group to timely respond to these Petitions, there is no basis for the Commissioner to now raise those issues. In short, there is neither surrender nor demonstration of the absence of the third step required by the *Pennu* decision, namely, a determination of whether the reissue claims are materially narrowed

in other respects so as to avoid the recapture rule. In short, the rejection is incomplete and improper on both the amendments presented during the prosecution of the parent claims and the arguments presented for patentability of those claims.

Relation Between Patented and Rejected Claims

The Examiner has argued that claim 20 can only relate to patented claim 7, and method claims 44-58 may only be related to patented claims 7 and 8. The Examiner has no authority to make this assertion, and there is no showing that these claims are not also related to patented apparatus claims 2 and 4.

The Examiner questions whether claim 20 should expressly state that Applicant's step of "making a subjective evaluation" is "being done during said system power standby mode" as established by claim 7. Claim 7 lacks Applicant step of "making a subjective evaluation". Consequently, claim 7 does not create any estoppel to Applicant's presentation of claims containing process steps that are not present in claim 7. By way of example, nothing in a doctrine of recapture presents Applicant from amending claim 7, by way of example, to include Applicant's step of "making a subjective evaluation". Consequently, there is nothing in the doctrine that prevents Applicant from presenting claim 20 with this process step.

The Examiner's attention is invited to the fact that claim 20 does define a step of "during said power standby mode of operation, selectively generating a code". Independent claim 1 defines a method in which "when the video cassette recorder is in said standby mode of operation", the recorder receives "a lack function code". Claim 2 defines a recorder having "a standby mode of operation wherein the video tape is not reproduced" while claim 4 defines a

recorder having “a standby mode of operation wherein the video tape is not reproduced.” Claim 7 alternatively defines a method of “checking” during “a system power standby mode of operation” for “a key-data input signal” while claim 8 defines “checking for an input signal, ... during a system power stand-by state.” Nothing in the arguments presented during prosecution, or in limitation added to the claims during prosecution, suggest that Applicant is forbidden from broadly defining an alternative step of “during said system power standby mode of operation, selectively generating a code” as set forth in line 5 of claim 20, in combination with a newly presented step of “making a subjective evaluation”, despite the fact that none of the pending claims expressly use this combination of language. Consequently, there is no basis for refusing allowance of claim 20 simply because Applicant does not expressly define step of making the evaluation during the system power standby mode, when neither the amendments to the claims presented during prosecution of the parent application, or the arguments presented in support of the allowance of those claims, state that the step of “evaluation” occurs “during the system power standby mode of operation.” Withdrawal of this rejection of claim 20 is therefore required.

The Examiner questions whether the arguments presented in the Brief in Applicant’s parent application in support of patentability of claim 8, require that independent claims 44, 48, 55 and 56 expressly recite either a “standby” mode as defined by claim 1 or a “power standby” as defined by claim 7 and 8? The Examiner asserts that reference to apparatus claim 4 as a basis for this reissue process/method claims can not provide a basis for recapture here. Applicant agrees with the Examiner’s assertion. The fact that claims 44 through 58 might be related in various aspects to apparatus claim 4, rather than claim 8 which was ultimately allowed by the

Board of Appeals is irrelevant to application of the doctrine of recapture. The Examiner's question ignores the fact that patented claim 7, rather than patented claim 8, with the subject matter of the Brief, and that the arguments presented and supported the patentability of patented claim 7 have nothing to do with the patentability of either patented claims 1 through 6 or patented claim 8. The fact that the "standby" mode may have been argued as a point of patentable distinction of patented claim 7, has nothing to do with patentability of apparatus claims 2 and 4, neither of which define specific process steps as occurring during a standby mode of operation. Patented claims 1 through 6 and 8 were allowed prior to Applicant's presentation of any arguments or remarks directed to the "standby" mode. Consequently, neither the amendments to patented claims 1 through 6 and 8 nor arguments presented in support of patentability of those claims creates a recapture bar to Applicant's presentation now of reissue process claims that perform certain steps that are not limited to occurrence during a standby mode. This permissible breath of scope according to Applicant's presentation of process claims conforms to the scope of the patented apparatus claims, which do not limit the operation of particular constituent elements to the occurrence of a standby mode. Withdrawal of this rejection is therefore required.

In summary, the foregoing deficiencies in application of the recapture rule, together with the fact that Applicant made no amendment of either patented method claims 1 and 7 or patented apparatus claims 2 and 4 to add any "power standby" limitation, and made no argument to justify patentability of these claims over the applied art, establishes that recapture does not exist. The Examiner is further reminded that claim 7 was the subject of the appeal, and that was the Board, rather than the Examiner who allowed claim 7. Claim 7 however, differs in scope, breadth, and

content from these rejected claims, as well as from claims 1, 2, 4 and 8. There is no basis therefore, in restricting the consideration of recapture to only patented claims 7 and 8.

II. There Is No Evidence In The Instant Record That Fairly Justifies A Rejection Of Claim 20 Under The Doctrine Of Reissue Recapture

K. The Examiner's Assertion That *Not All Features Of The Original Claims Were So Argued, Just That Listed Below As It Relates To The Method Claims Of The Same Reasonable Scope Is A Non Sequitur That Does Not Support The Examiner's Recapture Rejection Of Claim 20 Under 35 U.S.C. §251.*

On page 5 of the Examiner's Answer, paragraph 10, the Examiner argues that,

“[n]ot all features of the original claims were so argued, just that listed below as it relates to the method claims of the same reasonable scope ... [t]he present rejected claims do not include ‘*checking for a key-data input signal from said keyboard or remote control during a system power standby mode*’ as is required by arguments introduced by Applicant and further supported by the Opinion of the Board of Appeals (mailed 22nd of July 1997, page 6, lines 10-14 of the Opinion.” Examiner's Answer, pages 5.

The Examiner has distorted the prosecution history of Applicant's patent; in its *Findings Of Fact And Conclusions Of Law* issued on the 22nd of July 1997, the Board carefully examined seven (7) distinct limitations of patent claim 7 in paragraphs 10 through 18, and six (6) distinct limitations of patent claim 7 and last two paragraphs on page 11 and the first paragraph on page 12 of Applicant's amendment filed on the 1st of December 1998. The Board only addressed limitations raised by the Applicant in the Briefs. The distortion is explained in greater detail in conjunction with the following issue; but it suffices to recognize that Applicant argued more than the single feature of patent claim 7 which the Examiner now asserts is the *sine qua non* of the invention

defined by reissue claim 20. Additionally, the Examiner has improperly miscast Applicant's claim 20 as being of comparable scope to patent claim 7; patent claim 7 defines a process of *checking for key-data input* during a system standby mode, while reissue process claim 20 is directed to a different invention, with a process step of *generating a code* during a system power standby mode – claims 7 and 20 are directed to different inventions, a fact that seems to be lost upon the Examiner. The *non sequitur*²³ is best demonstrated by the fact that if the feature of claim 1 now argued by the Examiner were absent from claim 7, claim 7 would still probably be allowable over Bonneau because the Board found that “a preponderance of evidence” did not support the rejection. In short, the Board had already noted that “Bonneau's display step is not equivalent to the claimed display step. That is, the Board had more than one finding of fact to support its *Conclusion of Law*.

L. 35 U.S.C. §251 And The Doctrine Of Reissue Recapture Do Not Either Seize Upon Any Explanation Given By An Applicant In Support Of The Traversal Of An Art Rejection Or Use The Fact That Applicant Mentioned The Presence Of One Or More Aspects Of A Rejected Claim When Traversing An Art Rejection, As Creating An Insurmountable Bar To Allowance Of A Reissued Claim Which Fails To Recite The Identical Aspect Mentioned In The Applicant's Traversal.

In the Examiner's Answer (paragraph 11), page 4), the Examiner asserts that:

“The few critical elements under *Hester* argued by Applicant as essential to the method claim is the prosecution history : ‘*checking for a key-data input signal from said keyboard or remote control during a system power standby mode*’ as deemed critical by arguments first introduced by Applicant on page 8, lines 4-8 of their

²³ Technically, this argument in the Examiner's Answer is referred to in logic as an *ignoratio elenchi*, that is, a logical fallacy which consists in apparently refuting an opponent while actually disproving some statement different from that advanced by him (OED).

Brief, but restricted to only the above language in the Opinion of the Board of Appeals mailed 22 July 1997 (page 6). Examiner's Answer, page 6.

Although the Examiner concedes that the condition precedent for the creation of reissue recapture, mainly amendment of a claim in order to overcome a prior art rejection, did not occur during prosecution of the parent application (because Applicant's *checking* process step was present in patent claim 7 when that claim was first written in the amendment of the 10th of May 1993, the Examiner now asserts that the doctrine of reissue recapture prohibits allowance of any reissue claim that does not include all of the "structural features" that an Applicant mentioned in remarks traversing an anticipation rejection because the specific structural features mentioned in those remarks are absent from the rejected reissue claims.²⁴ Applicant's use of particular phrases referring to structural features of the claim simply buttresses the broad assertion that the Examiner's anticipation rejection based upon *Bonneau* is wholly unfounded and specious. The Examiner apparently agreed, and withdrew that rejection of apparatus patent claim 8 in the next correspondence. Moreover, the fact that this feature is wholly absent from patent claims 1 through 6 is additional evidence of the speciousness of the Examiner's current position about the criticality of this feature. Furthermore, the fact that Applicant did bring this feature of patent claim 7 to the attention of the Examiner in the Briefs that resulted in the 22nd of July 1997 Decision by the Board

²⁴ Unlike *Hester Industries*, Appellant made this statement but once, and the Board concurred, and refused to sustain the anticipation rejection of patent claim 7.

is simply customary practice under the Rules.²⁵ The Examiner's current attempt to create an estoppel from Applicant's compliance with the Rules is not supported by either *Pannu* or *Hester*.

The extreme breath of the express language of the fourth paragraph of 35 U.S.C. §251 in permitting, in timely filled reissue applications, the prospect of allowance of reissue claims "enlarging the scope of the claims of the original patent", argues against the convoluted reading of *Pannu* and *Hester Industries* now urged by the Examiner. A recognition that 35 U.S.C. §251 does not mandate that reissue claims include all of the features of either a specific one of several diverse patent or one of several features found by the Board to be patentably distinguishing in a patent claim that is directed to different subject matter, and a recognition that 35 U.S.C. §251 does not require that reissue claims that may have features that are similar to features of a particular patent claim use the verbatim language of the patent claim to define those feature, together with the fact that the *Pannu* and *Hester Industries* decisions of the Federal Circuit addressed reissue

²⁵ Under 37 CFR §1.111(b), in order to be entitled to reconsideration or further examination, the Applicant must provide a written reply, and that "reply must present arguments pointing out the specific distinctions believed to render the claims ... patentable over the applied references." The Examiners implementation of reissue recapture estoppel in the instant application argues that in 100% of the patents where an Applicant responds to an anticipation rejection, that Applicant's compliance with the express requirement of 37 CFR §1.111(b) forever after estops the Applicant from obtaining allowance of any reissue claim that defines an apparatus that is structurally different from that defined by the patent claim, simply because that reissue claim lacks the "specific distinctions [that were] believed to render the [patent] claims ... patentable over any applied references." This wholesale and blanket estoppel applies even where, as here, the anticipation rejection was frivolous and unwarranted by the prior art. Applicant here is not endeavoring to reargue the anticipation rejection based upon Chapin, because the Examiner has already concurred in the impropriety of that rejection, as is evidenced by the Examiner's withdrawal of that rejection and allowance of all of the patent claims. Moreover, Applicant did not endeavor to narrow the scope of coverage of the patent claims in an effort to avoid Chapin, but simply explained to the Examiner, in compliance with 37 CFR §1.111(b) why Chapin was an improper anticipation reference. Applicant's compliance with the rules of practice can not be said to create a reissue recapture estoppel that prevents Applicant from claiming other inventions disclosed in Applicant's original specification.

claims that differed only in scope from the patent claims while Applicant's claim 20 is directed to structurally different subject matter than is Applicant's patent claim 7, shows that there is no basis under the doctrine of reissue recapture to sustain the final rejection of reissue claim 20. Such action is respectfully requested.

The Examiner's efforts to misread and ignore the numerous features of patent claim 7 advanced by Applicant and the findings by the Board of more than a single basis ²⁶ for its determination that Bonneau failed to provide a proper vehicle to support an anticipation rejection of patent claim 7 is a *non sequitur* that fails to respond to either those general arguments against anticipation, or to recognize either that the patent claim 7 was found to be novel by the present of more than a single "*checking*" process, or the fact that rejected reissue claim 20 is directed to a different invention, one that involves a step of "*generating*" and defines a different invention. The Examiner's crafting of a reissue recapture based upon one argument provided to the Board in order to demonstrate the inadequacy of Bonneau as an anticipation reference will not sustain this rejection.

H. Claims 44, 45, 47 through 51, and 54 through 58 are rejected under 35 U.S.C. §251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

²⁶ The Examiner fails to recognize that Applicant presented more than one argument to demonstrate a lack of anticipation of patent claim 7 by Bonneau, and that the Board ruled upon the preponderance of evidence rather than a single claim limitation, after finding at least two features of patent claim 7 were not taught by Bonneau. The Examiner's attempt to create a generalization based upon one of those features is a *non sequitur*.

The Examiner refers the rejection to the previous Office Action, paragraphs 53-55

The Examiner maintains the rejection of claims 20,44, 45, 47-51 and 54-58 under 35 U.S.C. §251 as being improper recapture of broadened claimed subject matter is maintained “since the applicant has merely reiterated the Office’s opinion from the previous Office Action as found in Sections G and H of the Applicant’s response.”

The Examiner states that:

Again, the test for recapture requires the examiner to review the claim for the presence of broadening, as compared with the scope of the claims of the patent to be reissued. A reissue claim is broadened where some limitation of the patent claims is no longer required in the reissue claim. That is, a claim of a reissue application enlarges the scope of the claims of the patent if it broader in at least one respect, even though it may be narrower in other respect. In the instant case, claims 44, 45, 47-51, and 54-58 are broadened since at least one limitation, such as **displaying a lock function setting state . . . and sequentially storing and displaying a secret code of a user**, is no longer required.

The second step requires the examiner to determine whether the broadening aspects of the claim relate to subject matter that applicant previously surrendered during the prosecution of the original application. There are two sub-steps involved with this step. Firstly, it must first be determined whether there was any surrender of subject matter in the prosecution of the original patent. The reliance by applicant on a claim limitation to define the original patent claims over the prior art can be made by way of presentation of new/amended claims or an argument/statement by the applicant that a limitation defines over the art. Paragraph #49 above sets forth the surrender generating limitations, that is, the limitations found in the prosecution history which were argued by the applicant for patentability over the prior art, Secondly, since there was a surrender of subject matter, it must be determined whether any of the broadening of the reissue claims is in the area of the surrendered subject matter. As none of claims 44, 45, 47-51, and 54-58 contain

any of the surrender generating limitations, the broadened reissue claims improperly recapture surrendered subject matter.

The third step requires the analysis of the broadening and narrowing effected via the reissue claims and of the significance of the claim limitations added and deleted to determine whether the reissue claims should be barred as recapture. The limitations presented, argued, or stated to make the claims patentable over the prior art generates the surrender of claimed subject matter and is therefore referred to as the surrender-generating limitation. If a claim is presented in a reissue application that omits in its entirety, the surrender-generating limitation, that claim impermissibly recaptures what was previously surrendered, and that claim is barred under 35 USC 251. The arguments in the prosecution history directed to pointing out the specific limitations to define over the prior art, such as set forth in paragraph #49 above has resulted in the surrender of any combination of steps that does not include at least one of the surrender generating limitations. Thus, even though the claim may be narrowed in some respect not related to the surrender generating limitation, the broader claims are barred by the recapture rule.

The Examiner's assertion is a circuitry of logic, and therefore faulty. In point of fact, what the Examiner asserts to be a "surrender generating limitation" is language of one or eight claims pending in the parent patent application was in fact language which appeared in one claim presented to the Board of Patent Appeals And Interferences. Contrary to the Examiner's suggestion, this was not a limitation added to that claim which resulted in the amended claim then overcoming the plurality of outstanding art rejections.

Moreover, the Board neither amended that claim nor stated that the addition of the Examiner's "surrender generating limitation" would place that claim in condition for allowance.

Furthermore, the Board made no ruling upon any of Applicant's seven allowed claims.

In short, the Examiner has failed to make a *prima facie* showing of reissue recapture. The fact that the Board refused to sustain a rejection, and in point of fact articulated multiple reasons why each of the plurality of art rejections could not be sustained, does not convert the language in the sole claim on appeal that may correspond to each of those reasons into a “surrender generating limitation.” Withdrawal of this rejection is therefore respectfully urged.

Claim Rejections - 35 U.S.C. §103

- F. Claims 9 through 13, 15 through 19, 24, 25, 29 through 33, 35 through 43 are rejected under 35 U.S.C. §103(a) as being unpatentable over Rew (5,033,085) in view of Inagaki et al (4,896,354).**

Claims 9 through 13, 15 through 19, 24, 25, 29 through 33, and 35 through 43 were rejected under 35 U.S.C. § 103 (a) as rendered obvious, and unpatentable over the Examining staff's proposed combination repeated citation of a proposed combination of Rew U.S.C. Patent No. 5,033,085 filed on the 27th June 1988, modified according to Inagaki *et al.* U.S. Patent No. 4,896,354 filed on the 11th of October 1985. Applicant respectfully repeats its traversal of these rejections for the following reasons.

In support of this rejection, the Examiner states that:

Rew teaches a method and system for controlling video and audio of a television set including a microcomputer 4 responding to input signals selectively input from a keyboard 1 or a remote control 2 for controlling the production of video and audio signals through generation of a control output SAN and PAN, a video processor and audio processor for receiving and processing video and audio

signals in the form of detecting element 62, a character generating circuit incorporated within the microcomputer and a video/audio mute circuit for muting the video and audio information from being output to a display element 67 or audio speaker 66. Inagaki et al are directed to an image reception system, i.e. a video system, including control for blocking the video outputs to be displayed on a display screen including in a similar manner, remote control 10, video processor 3, microcomputer 5, character generator 6, and a masking circuit 7 and mixing circuit 8. the previous Office Action sets forth the particular reasons for combining/modifying the prior art. The combination of references substitutes the masking and mixing circuits into Rew. Thus, the combination additionally shows the mixer generating video components by mixing the received video signal and a second video signal, in the form of generated characters, as well as a video mute circuit responding to a control output from the microcomputer which masks, i.e. prevents, the video signal from being applied to the mixer. The claimed "time period" as noted previously is defined by the period of time that simply exists between two subsequent inputs of code data; thus the prior art meets the scope thereof since a period of time exists between entry of a locking code and entry of an unlocking code, or vice versa, between an unlocking code and a locking code. When the unlocking code is entered subsequent to the video system being locked, a time period has existed between when the video system was locked and when the system was unlocked; this time period expired in the same manner as the claimed expiration of time via the fact that a subsequent entry of code was inputted. Figure 5 further shows the prompting on the screen of the entry of a code one at a time.

The primary reference, Rew'085, contemplates that when,

"no code is set up in the television set, the television set is driven normally by pressing the power key only as in the conventional way"²⁷

and that,

"in a state that a code is set up in the television set, the television

²⁷

Rew'085, column 1, lines 32-35.

set is not driven normally when the power key is pressed ... [] there is displayed a code set-upstate, and then as a key signal corresponding to the code is input, the code set-upstate displays is released and at the same time, the video and audio signals of the television broadcaster are output normally.”²⁸

The secondary reference, Inagaki *et al.* ‘354, teaches a character generator 6, a blanking or masking circuit 7 for superimposing a masking signal on the video signal received from the video detector 3 on the basis of command data drive from microcomputer 7, in order to thereby blank the vide signal. Mixing circuit 8 mixes the character information from the character generator and display controller 6 together with the output from the masking circuit 7.²⁹

A. The rejection of claims 7, 9 through 19, 27 through 43 and 59 fails to make a *prima facie* showing of obviousness under 35 U.S.C. §103(a)

This rejection of claims 7, 9 through 19, 27 through 43 and 59 fails to meet the criteria of the Office for a *prima facie* showing of obviousness under 35 U.S.C. §103(a). According to MPEP 706.02(j), the criteria for establishing a *prima facie* case of obviousness under 35 U.S.C. §103 mandates that:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. **First**, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. **Second**, there must be a reasonable expectation of success. **Finally**, the prior art reference (or references when combined) must teach or suggest all the claim

²⁸ Rew’085, lines 36-44.

²⁹ Inagaki *et al.* ‘354, column 2, lines 34-45.

limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

Applicant respectfully suggests that none of these criteria has been met by Paper No. 41.

Claim 9

In support of this rejection the Examining staff urged that:

"Rew operates such that during a power standby mode, a power key signal input is entered by the keyboards/remote controller (3: §7-4:3). This power key input meets the scope of the claim *lock key* or *lock key data*."³⁰

The Examining staff has ignored paragraphs 10 through 18 and 20 through 27 of the decision of the Board of Patent Appeals and Interferences (Paper No. 35) entered only the 22nd of July 1997, appeal No. 95-1187, which constitutes the administrative record and law of the case specific to this application. The holding of the Board and its reasoning may not be summarily dismissed by the Examining staff and a misguided effort to reconstruct the art in light of Applicant's claims. Pending claims 9, 15, 24 and 25 contemplate, among other features,

"input of lock key data ...,"³¹

and,

"generating said first control output for a period of time defined by a first input of lock key data followed by a first input of a secret code and a second input of said lock key data followed by a second

³⁰ Paper No. 41, page 5.

³¹ Claim 9.

said input of said secret code”³²

These features are not met by the Examining staff’s proposed combination; instead, the manipulation of “this power key input” takes the Examining staff’s proposed combination out of the scope of claims 9, 24 and 25. Nothing in the secondarily reference cures this deficiency in the proposed combination, because Inagaki’354 uniformly initiates his “code registration” and “code verification”, as well as his “block channel registration” with “a normal television picture” being displayed as shown in figure 4 of Inagaki’354. Consequently, the Examining staff’s proposed combination fails to make a *prima facie* showing of Applicant’s process set forth in claims 9, 24 and 25. Withdrawal of the rejection therefore is required. Moreover, the failure to consider the express finding of the Board negates any suggestion of obviousness under 35 U.S.C. §103 (a).

Claims 9 and 15

Unlike the Examining staff’s proposed combination, Applicant’s claims 9 and 15 defines, *inter alia*, a:

“[m]icrocomputer responding to inputs signals selectively input ... by controlling production of video images corresponding to said video components through generation of a control output for a period of time defined by a first input of lock key data followed by a secret code and a second input of said lock key data followed by said secret code”

This, in combination with Applicant’s “mixture generating said video components by mixing said first video signal and said second video signal” can only be found in the Examining staff’s

³² Claims 24 and 25.

proposed combination through an impermissible hindsight reconstruction of the art in light of the blueprint provided by Applicant's claim 9. In fact, this is what the Examining staff has done by asserting that:

“the masking circuit (7) and mixing circuit (8) provides a substantially equivalent function (erase/mute audio/audio signals when locked) and substantially equivalent environment (video system and TVR CTV) for a substantially equivalent purpose (to providing control over viewable media) to the switching element of Rew,”³³

and that:

“[i]t would've been obvious ... to modify Rew by substituting a conventional masking circuit/mixing circuit for the switching element in Rew as taught by Inagaki et al. in order to effectively blank the video/audio signals from the output terminal of the video system and prevent viewing programs considered harmful ... since the masking/mixing circuit provides advantage of the capability to simultaneously display video as well as on-screen character data, such a channel or time information, when both video and character data are available.”³⁴

Contrarily to the admonition of §706.02(j) of the *Manual of Patent Examining Procedure*, 8th Edition, Revision 5, the Examining staff has provided absolutely no “suggestion or motivation either reference themselves or the knowledge generally available to one of the ordinary skill of art, to modify” the primary reference according to Inagaki'354 to incorporate the masking circuit 7 and mixing circuit 8. Moreover, the teaching in the primary reference expressly negates any need for such a modification, because the primary reference, as illustrated in the enclosed

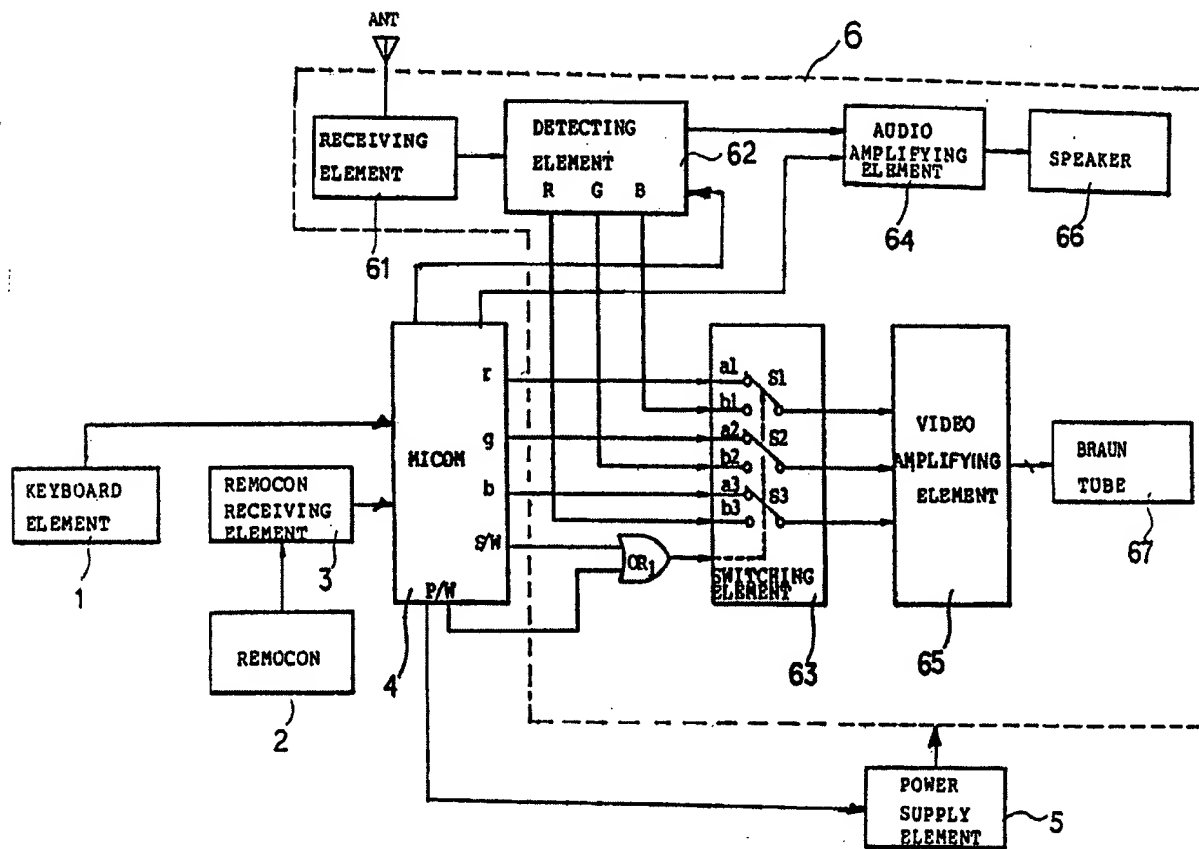
³³ Paper No. 41.

³⁴ Paper No. 41, page 8.

modification of figures 1 and 2,

U.S. Patent 5033085

FIG. 2



uses microcomputer 4 to create its "On-Screen character display on the Braun tube" as is demonstrated by figure 3 (A), and by figures 4 and 5. Not only is this proposed modification of the primary reference unsupported by evidence of motivation for making the modification, the modification unnecessary and produces a useless circuit. **First**, the primary reference teaches by a single video signal, namely the R,G,B video passed by "detecting element 62" and applied to "video amplifying element 65" via "switching element 63." A "mixing circuit 8" mixed two, or more, video signals such as the output of "detector 3" and "character generator 6" of Inagi '354. Recognizing that the primary reference uses but one video signal, precisely what two video signals do the Examining staff's proposed combination mix? Clarification is respectfully requested in subsequent Office correspondence. **Second**, the Examining staff has ignored the express teachings of the primary reference, which intends to operate in a very specific mode of denying any and all "unauthorized use of a television set."³⁵ This is a different mode of operation from Applicant's "video system." Specifically, Rew '085 operates in its denial of any and all "unauthorized use of a television set" with the result that:

"if a code N1 is set up ... microcomputer 4 outputs an audio erasing signal so that no audio signal is output from the audio amplifying element 64, and also outputs the video erasing and switching signals so that the switches S1-S3 of the switching element 63 are **short circuited** ... and **at the same time** the ON screen character display signals output from the microcomputer 4 are displayed on the Braun tube 67 through the switching element 63 and the video amplifying element 65."³⁶

³⁵ See, by way of example, the especially apt characterization of the intended mode of operation of Rew '085 stated in the preambles of its claims 1 through 3.

³⁶ Rew '085, column 3, lines 17-24.

Consequently, there is no need to “mix” any video signals, or to use a “mixing circuit 8” from the secondary reference, or to make any other modification of the primary reference in order to obtain the absolute denial of any and all “unauthorized use of a television set” intended by the primary reference because, as explained by the primary reference,

“the video and audio erasing signals are, thereafter, output *at the same time* the switching signals are output”³⁷

Unlike the primary reference, Inagaki ‘354 contemplates the use of “mixer circuit 8” in its “reception block” mode of operation, to accommodate, among video signals, a video display of “OUT BAND DATA such as an emergency broadcast data and so on from the front end 1” as well as frequency shift data from “FSK 9”;³⁸ this is unnecessary and undesired in the primary reference.

Furthermore, the modification proposed by the Examining staff would impermissibly prevent the primary reference from operating in its intended mode of operation, with,

“any person who does not know the code [being] unable to drive the television set”³⁹.

The sole video image displayed on the Braun tube is provided by r,g,b signals provided by “Micom 4” through switching element 63, which in the teachings of the primary reference, not only avoids the possibility of an external source of a video signal being applied directly to mixing circuit 8, as is demonstrated by Applicant’s figure 2, in order to circumvent the blocking circuit

³⁷ Although in this passage Rew ‘085 is discussing his sequence for resetting the code, the statement is uniformly applicable to all of the operations performed by Rew ‘085.

³⁸ Inagaki ‘354, column 2, lines 41-49.

³⁹ Rew’085, column 4, line 64.

and generate a video signal on the television receiver, but displays only a single image at any one time by the simple expedient of designing a circuit in which:

“the microcomputer 4 outputs an audio erasing signal so that no audio signal is output from the audio amplifying element 64, and also outputs the video erasing and switching signals so that the switches S1-S3 of the switching element 63 are short circuited to terminals a1-a3 on one side and the same time the On screen character display signals are output.”⁴⁰

Without the Examining staff’s proposed combination, either surreptitious efforts to circumvent the blocking aspect of the primary reference may not be reliably prevented due to the presence of a mixing circuit which may, in essence, be employed as a port for unauthorized video signals from another source such as a video cassette player or a DVD player, a risk that is prevented due to the absence of a mixing circuit 8 in the blocking scheme of the primary reference, or alternative sources of video signals such Inagaki ‘354’s contemplated the use of “mixer circuit 8” in its “reception block” mode of operation, to accommodate, among video signals, a video display of “OUT BAND DATA such as an emergency broadcast data and so on from the front end 1” as well as frequency shift data from “FSK 9”⁴¹, all of which would readily defeat the absolute denial of any and all “unauthorized use of a television set” intended by the primary reference with:

“any person who does not know the code [being] unable to drive the television set”⁴².

This incorporation of masking circuit 7 and mixing circuit 8 from Inagi ‘354 into the primary

⁴⁰ Rew ‘085, column 3, lines 18-24.

⁴¹ Inagaki ‘354, column 2, lines 41-49.

⁴² Rew’085, column 4, line 64.

reference neglects to consider that the intended mode of operation of the primary reference is stated to be:

“[a]ccordingly, the video signals output from the detecting element 62 do not pass the switching element 63, and the On screen character display signals output from the microcomputer 4 are displayed on the Braun tube 67 through the switching element 63 and the video amplifying element 65. Consequently, the user may perceive that the code is set up.”⁴³

Consequently, and ignoring *arguendo* that failure of the Examining staff’s proposed combination to present a *prima facie* showing of obviousness, this rejection is impermissible, and contrary to the probation against hindsight reconstruction of the art in light of the Applicant’s teachings, and it unnecessarily prevents the primary reference from operating in its intended mode of operation. Withdrawal of this rejection is therefor required.

Claim 35

Applicant’s claim 35 contemplates the microcomputer,

“controlling broadcast of all audio sounds ... through generation of a control output for **a period of time** defined by the first input of lock key data followed by the first input of the secret code and the second input of the lock key data followed by the second input of a secret code,”

in combination with:

“a mixer generating said video components by mixing said first

⁴³ Rew ‘085, column 3, lines 24-31. In other words, the user is alerted to the fact that the code N1 has been set up by the absence of any image appearing on Braun tube 67 that corresponds to the video signals output from the detecting element 62, because those video signals do not pass switching element 63.

video signal and said second video signal”

In contradistinction, the Examining staff’s proposed combination lacks any aspect of Applicant’s “generation of a control signal for a period of time” in the manner implemented by the Applicant, which deleteriously exposes the mixer in the proposed combination to generation of video components, a result that is explicitly contrary to the teaching of the absolute denial of any and all “unauthorized use of a television set” intended by Rew ‘085 so that

“any person who does not know the code [being] unable to drive the television set”⁴⁴.

To assure the implementation of this intended absolute denial of any and all “unauthorized use of a television set”, Rew ‘085 “outputs an audio erasing signal so that no audio signal is output from the audio amplifying elements 64” under conditions of a set up of code N1. This, together with the fact that the Examining staff’s proposed combination is singularly devoid of Applicant’s “lock key data followed by import of the secret code” and instead proposes to substitute the power-on key therefore, is convincing *indicia* of an absence of obviousness and lack of *prima facie* demonstration of that obviousness. Withdraw of this rejection of claim 35 is therefore required.

B. The rejection of claims 9 through 13, 15 through 19, 24, 25, 29 through 33 and 35 through 43 lacks a demonstration of motivation for making the Examining staff’s proposed combination under 35 U.S.C. §103(a)

Utterly devoid from the applied art is any evidence of motivation for modifying the primary reference to incorporate a mixer from the secondary reference; the primary reference

⁴⁴ Rew’085, column 4, line 64.

performs according to its disclosed mode of operation wholly without a mixer. The primary reference has neither need nor generation of any video signals to mix. The fact of the matter is that on the evidenc of record in this application, the Examining staff's proposed combination including Rew '085 has but a single video signal R,G,B generated by detecting element 62;⁴⁵ note that Rew '085 uses microcounmpter 4 to generate "[t]he ON screen character display signals ... r,g,b... ."⁴⁶

Nowhere does the Examining staff's proposed combination pretend that the *ON screen character display signals* output from the output terminals r,g,b of the microcomputer 4 are either video signals or are interchangeable with the *video signals* output from the output terminals R,G,B of the detecting element 62; any argument to the contrary by Paper No. 41 is technical fantasy unsupported by the art of record. Precisely what video signals is the Examining staff's proposed combination intended to "mix" in "mixing circuit 8" of the Examining staff's proposed combination when "microcomputer 4" simply supplies "On Screen Character display signals r,g,b to video amplifier 65? The sole basis of record for the Examining staff's proposed modification is therefore, an impermissible reconstruction of the art in the light of Applicant's teachings, as are set forth in the pending claims. Withdrawal of this rejection is thus required.

⁴⁵ Rew '085, column 2, lines 37 and 38.

⁴⁶ Rew '085, column 2, lines 34-41, "The *ON screen character display signals* output from the output terminals r,g,b of the microcomputer 4 or the *video signals* output from the output terminals R,G,B of the detecting element 62 are designed to be input to the video amplifying element 65 through switches S1-S3 of the switching element 63."

C. The rejection of claims 9 through 13, 15 through 19, 24, 25, 29 through 33 and 35 through 43 fails to consider the “subject matter as a whole” as is required by 35 U.S.C. §103(a)

35 U.S.C. §103(a) requires that “the subject matter as a whole” be considered in a determination of obviousness. Instead, the Examining staff has summarily made a piecemeal review of Applicant’s claims 9 through 13, 15 through 19, 24, 25, 29 through 33 and 35 through 43 by, among other deficiencies, ignoring the relation between Applicant’s structural and process features, and focusing upon partial aspects of the pending claims in a misguided effort to demonstrate obviousness under a point-of-novelty criterion. As one example of this discredited approach, in support of this approach to 35 U.S.C. §103(a), the Examining staff wrote in Paper No. 41 that:

“Rew discloses a method and system for controlling video ... of a television set having a standby mode of operation via the fact that a remote control receiver (3) is powered during standby to be responsive to a remote control unit (2) for subsequent powering up of the video system at turn on.”

Utterly ignored is the fact that the Examining staff’s proposed combination including Rew ‘085 is “responsive to a remote control unit (2) ~~for subsequent~~ simultaneously with powering up of the video system at turn on” because the Examining staff’s proposed combination has only “the power key of the keyboard element 1 or remote control 2” In essence, Paper No. 41 has inaccurately characterized selected features of the proposed combination of the prior art in an effort to reconstruct Applicant’s claims.

In another example, Paper No. 41 write that,

“[t]his power key input meets the scope of the claimed ‘lock key’

or 'lock key data',”

although the record is devoid of any evidence that the “power key input meets the scope of the claimed ‘lock key’ or ‘lock key data’.” Moreover, the response of the Examining staff’s proposed combination to the “power key input”, namely:

“the microcomputer 4 directs **normal** operation of the system as in a conventional television set. In other words, the microcomputer 4 controls the detecting element 62 by the remote control key signal of the keyboard element 1 or remote control 2 to select the television broadcasting signals, and the video signals of the selected broadcasting signals are displayed on the Braun tube through the switching element 63 and the video amplifying element 65, and the audio signals are output to the speaker 66 through the audio amplifying element 64.”⁴⁷

This behavior of the Examining staff’s proposed combination is not what is described by the Examining staff in Paper No. 41; that is, the description set forth in Paper No. 41 is technically inaccurate. Where, for instance, is the teaching in the proposed combination of “the scope of the claimed ‘lock key’ or ‘lock key data’?” There is not evidence of record to support this unusual characterization of the “power key of the keyboard element 1 or remote control 2.”⁴⁸ Moreover, this mischaracterization of the teachings of the proposed combination is fiction. Furthermore, where are such features of Applicant’s claims 7 and 28, by way of example, as:

“determining whether the lock state of said system is a locked state or an unlocked state after a last character of said secret code has been input;
storing the input secret code as a lock secret code, clearing the display screen and locking the video system when the lock state is

⁴⁷ Rew ‘085, column 3, lines 3-16.

⁴⁸ Rew ‘085, column 2, lines 67 and 68.

determined to be in said unlocked state;
comparing the input secret code with a lock code previously stored
in the microcomputer when the lock state is determined to be in
said locked state...”;

of claim 29, or

“a microcomputer responding to input signals selectively input from
a keyboard or a remote control receiver by controlling display of
video images corresponding to said video components through
generation of a control output for a period of time defined by a first
input of lock key data followed by a first input of a secret code and
a second input of said lock key data followed by a second input of
a secret code;”

of Applicant’s claim 35, or

“a microcomputer responding to input signals selectively input from
a keyboard or a remote control receiver by controlling broadcast of
audio sounds corresponding to said audio components through
generation of a control output for a period of time defined by a first
input of lock key data followed by a first input of a secret code and
a second input of said lock key data followed by a second input of
a secret code ...”?

Paper No. 41 is silent, and despite its unusual length, Paper No. 41 fails to address these, and
other, aspects of the pending claims. In point of fact, nothing in the proposed combination
responds in this manner to Applicant’s lock key data. This piecemeal and incomplete approach
to determinations of obviousness is unlawful under 35 U.S.C. §103(a); consequently, this
rejection should be withdrawn, and claims 9 through 13, 15 through 19, 24, 25, 29 through 33 and
35 through 43 allowed.

CONCLUSION

37 CFR §1.173(c) does not purport to equate the noun *amendment* to the noun *changes*. Contrary to the assertions of the Examiner, the express language of 37 CFR §1.173(c) does not declare that every *amendment* of a claim is also a *change* made to that claim. Moreover, Applicant respectfully notes that Paper No. 20070116 has not identified any *change* in any of the claims. Withdrawal of this objection is therefore respectfully urged.

In view of the foregoing explanations and remarks, all claims are deemed to be in condition for allowance. Should any questions remain unresolved however, the Examiner is requested to telephone Applicant's attorney.

Respectfully submitted,



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